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PATENT APPLICATION

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

ATTORNEY DOCKET NO.   __10011083 -1__

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Rajeev Grover et al	Confirmation No.: 4790
Application No.: 09/966620	Examiner: Brian J. Gillis
Filing Date: Sep 27, 2001	Group Art Unit: 2141

Title: **Configuring A Network Parameter To A Device**

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on __September 8, 2005__ .

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐(a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month $120	☐ 2nd Month $450	☐ 3rd Month $1020	☐ 4th Month $1590

☐ The extension fee has already been filed in this application.

☒(b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of __$ 500__ . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Date of facsimile: November 7, 2005   **31 Pages**

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Respectfully submitted,

Rajeev Grover et al

By_____

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HEWLETT-PACKARD COMPANY
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Docket No.: 10011083-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	
Rajeev Grover et al	
Application No.: 09/966,620	Confirmation No.: 4790
Filed: September 27, 2001	Art Unit: 2141
For: Configuring A Network Parameter To A Device	Examiner: Brian J Gillis

APPELLANT'S BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This brief, in compliance with 37 C.F.R. § 41.37, is in furtherance of the Notice of Appeal filed in this case on September 8, 2005.

The fees required under § 41.20(b)(2) and any required petition for extension of time for filing this brief and fees are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

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This brief contains items under the following headings as required by 37 C.F.R.
§ 41.37:

       I.   Real Party In Interest

       II.   Related Appeals and Interferences

       III.   Status of Claims

       IV.   Status of Amendments

       V.   Summary of Claimed Subject Matter

       VI.   Grounds of Rejection to be Reviewed on Appeal

       VII.   Argument

       VIII.   Claims Appendix

       IX.   Evidence Appendix

       X.   Related Proceedings Appendix

The final page of this brief bears the attorney's signature.

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal is Hewlett-Packard Development Company, L.L.P., a Texas limited liability partnership having its principal place of business in Houston, Texas.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeal or interference.

III. STATUS OF CLAIMS

A.   Total Number of Claims in the Application: 23 claims, which are identified as claims 1-23.

B.   Current Status of Claims
   1.   Claims canceled: 8 and 11
   2.   Claims withdrawn from consideration but not canceled: None
   3.   Claims pending: 1-7, 9, 10, and 12-23
   4.   Claims allowed: None
   5.   Claims rejected: 1-7, 9, 10, and 12-23

C.   Claims on Appeal: 1-7, 9, 10, and 12-23

IV. STATUS OF AMENDMENTS

Appellant filed a Response After Final Rejection on July 1, 2005 (hereinafter "Final Response"). The Examiner responded to the Final Response with an Advisory Action mailed August 10, 2005, in which the Examiner stated that "Appellant's arguments have been fully considered but they are not persuasive."

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V.   SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 is a method embodiment for configuring a first parameter to a first device (fig. 2). The method comprises the steps of providing a network communication channel (fig. 1, 150) connected to the first device (fig. 1, 120) and to a configuring machine (fig. 1, 130); from the configuring machine, sending the first parameter and a device's identifier to the communication channel (page 11, lines 6-7); acquiring the first parameter upon identifying the device's identifier on the communication channel (page 12, lines 1-3); configuring the first parameter to the first device (page 12, lines 4-6); and turning-off a feature to configure the first device until the first device is in an un-configured state (page 8, lines 14-16); wherein the first device is embedded in a second device and provides administrative capabilities to the second device (fig. 1, 120, 110; page 6, lines 4-6).

Claim 2 is a dependent claim to independent claim 1 that recites that the method of claim 1 wherein the first device further provides console capabilities to the second device (page 6, lines 6-16).

Claim 3 is a dependent claim to claim 1 that recites that the method of claim 1 wherein the step of sending comprising the steps of: sending the first parameter to a table in the configuring machine (page 9, lines 13-17); and obtaining the first parameter from the table (page 9, lines 17-19).

Claim 4 is a dependent claim to independent claim 3 that recites that the method of claim 3 wherein: the first parameter is an internet protocol address; an address resolution protocol command sending the internet protocol address to the table (page 9, lines 15-17); and a packet internet groper protocol command obtaining the internet protocol address from the table (page 11, lines 15-19).

Claim 5 is a dependent claim to independent claim 1 that recites that the method of claim 1 wherein the device's identifier is a media access control address of the first device (page 11, lines 7-9).

Claim 6 is a dependent claim to independent claim 1 that recites that wherein the first device performing the step of acquiring the first parameter (page 12, lines 3).

Claim 7 is a dependent claim to independent claim 1 that recites wherein the step of acquiring comprises the steps of: the second device obtaining the first parameter, and acquiring the first parameter from the second device (page 9, line 24 to page 10, line 2; page 6, lines 1-3).

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Claim 8 has been canceled.

Claim 9 is a dependent claim to independent claim 1 that recites that wherein the first device communicates with the second device via an interconnect selected from a group consisting an input-output interconnect, a peripheral component interconnect bus, an industry standard architecture bus, an extended industry standard architecture bus, an infini band, and a personal computer memory card international association standard (page 5, line 20 to page 6, line 1).

Claim 10 is a dependent claim to independent claim 1 that recites wherein the device's identifier is selected from a group consisting of an internet protocol address of the second device, a media access control address of the second device, and an asynchronous transfer mode address of the second device (page 10, lines 1-2).

Claim 11 has been canceled.

Claim 12 is a dependent claim to independent claim 1 that recites that the method of claim 1 further comprising the step of configuring a second parameter to the first device, the second parameter being sent with the first parameter in a packet (page 10, lines 3-4 and 8-9).

Claim 13 is a dependent claim to independent claim 1 that recites that the method of claim 1 further comprising the step of sending a command with the first parameter in a packet, the command being executed in the first device (page 10, lines 10-16).

Claim 14 is a dependent claim to independent claim 1 that recites that the method of claim 1 wherein the step of acquiring comprises the step of checking whether the first parameter is valid (page 7, line 23 to page 8, line 2).

Independent claim 15 is method embodiment for configuring a parameter to a first device. The method comprises the steps of: providing a network communication channel (fig. 1, 150) connected to the first device (fig. 1, 120) and to a configuring machine (fig. 1, 130); from the configuring machine, sending the parameter and a device's identifier to the communication channel (page 11, lines 6-7); acquiring the parameter upon identifying the device's identifier on the communication channel (page 12, lines 1-3); configuring the parameter to the first device (page 12, lines 4-6); and turning-off a feature to configure the first device until the first device is in an un-configured state (page 8, lines 14-16); wherein the first device is embedded in a second device and selected from a group consisting of a device providing tools managing the second device; a device providing mirror capabilities to the second device; a device providing interactions between the second device and a third device;

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and a device providing console capabilities to the second device (fig. 1, 120, 110; page 6, line 6 to page 7, line 4).

Independent claim 16 is a network, which comprises: a first device being embedded in a second device and providing administrative capabilities to a second device (fig. 1, 120, 110; page 6, lines 4-6); a network communication channel connecting the first device and a configuring machine (fig. 1, 150, 120, 130); means for sending a network address and a device's identifier from the configuring machine to the communication channel (fig. 3, 130; page 9, lines 7-8); means for acquiring the network address upon identifying the device's identifier on the communication channel (fig. 1, 140, 120; page 7, lines 21-23; page 12, lines 1-3); and means for the first device to configure the network address to the first device (fig. 1, 140; page 8, lines 8-14); wherein after the first device is configured with the network address, a feature to configure the first device is turned off until the first device is in an un-configured state (page 8, lines 14-16).

Claim 17 is a dependent claim to independent claim 16 that recites that the network of claim 16 wherein the device's identifier is a media access control address of the first device (page 11, lines 7-9).

Claim 18 is a dependent claim to independent claim 16 that recites that the network of claim 16 wherein the first device further provides console capabilities to the second device (page 6, lines 6-16).

Independent claim 19 is a computer-readable medium embodying instructions for a computer to perform a method embodiment (page 15, lines 12-14; line 18 to page 16, line 7) for configuring a first parameter to a first device (fig. 2). The method comprises the steps of providing a network communication channel (fig. 1, 150) connected to the first device (fig. 1, 120) and to a configuring machine (fig. 1, 130); from the configuring machine, sending the first parameter and a device's identifier to the communication channel (page 11, lines 6-7); acquiring the first parameter upon identifying the device's identifier on the communication channel (page 12, lines 1-3); configuring the first parameter to the first device (page 12, lines 4-6); and turning-off a feature to configure the first device until the first device is in an un-configured state (page 8, lines 14-16); wherein the first device is embedded in a second device and provides administrative capabilities to the second device (fig. 1, 120, 110; page 6, lines 4-6).

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Claim 20 is a dependent claim to independent claim 19 that recites that the computer-readable medium of claim 19 wherein the device's identifier is a media access control address of the first device (page 11, lines 7-9).

Claim 21 is a dependent claim to independent claim 19 that recites that the computer-readable medium of claim 19 wherein the first device further provides console capabilities to the second device (page 6, lines 6-16).

Claim 22 is a dependent claim to independent claim 19 that recites that the computer-readable medium of claim 19 wherein the method further comprising the step of configuring a second parameter to the first device, the second parameter being sent with the first parameter in a packet (page 10, lines 3-4 and 8-9).

Claim 23 is a dependent claim to independent claim 19 that recites that the computer-readable medium of claim 19 wherein the method further comprising the step of sending a command with the first parameter in a packet, the command being executed in the first device (page 10, lines 10-16).

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

On page 2 of the Final Office Action, claims 1-10 and 12-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,385,648 issued to Philippou et al (hereinafter "Philippou") in view of U.S. Patent No. 6,782,474 issued to Ylonen et al (hereinafter "Ylonen"). The Advisory Action, page 2, repeated this rejection.

VII.   ARGUMENT

REJECTIONS UNDER 35 U.S.C. § 103(a) – Philippou and Ylonen

On page 2 of the Final Office Action, claims 1-10 and 12-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Philippou in view of Ylonen. It is respectfully submitted that Philippou and Ylonen, either alone or in combination, do not teach every element of the claimed inventions. The alleged motivation for combining Philippou and Ylonen is improper. Showing of a prima facie case of obviousness fails.

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<u>CLAIMS 1, 16, 19</u>

1) <u>Philippou and Ylonen, either alone or in combination, do not teach every element claims 1, 16, 19</u>

Philippou and Ylonen, either alone or in combination, do not teach at least that the claimed first device is embedded in a second device and provides administrative capabilities to the second device and that a feature to configure the first device is turned off until the first device is in an un-configured state.

a) <u>Philippou does not teach that the claimed first device is embedded in a second device and provides administrative capabilities to the second device</u>

The Final Office Action, page 2, 4th paragraph, corresponded the claimed "providing a network communication channel connected to the first device and to a configuring machine" to Philippou's figure 2 with "a box and a configuring box connected through a network." In fact, Philippou's figure 2 shows a box 205 and a box 201 having a configuration utility 231 that, for the sake of argument only without conceding prior art teaching, may be parallel to the claimed first device and configuration machine, respectively.

Assume for the sake of argument that Philippou's to-be-initialized box 205 corresponds to the claimed *first device* to be configured, both the Final Office Action and the Advisory Action never showed that Philippou's box 205 is *embedded* in a second device and *provides administrative capabilities to this second device* as the claimed first device. A careful review of Philippou revealed that Philippou does not teach box 205 is embedded in a second device and provides administrative capabilities to this second device. Philippou's figure 2 does not show box 205 is embedded in any device, and the text related to box 205 does not mention that box 205 is embedded in any device or that box 205 provides administrative capabilities to the device in which box 205 is embedded.

Further, claim 1 now includes the feature of canceled claim 8 that recites "the first device is embedded in a second device" where as canceled claim 8 recited ". . . the first device being part of the second device." The rejection of claim 8 is now discussed. The Final Office Action, page 4, 5th paragraph, asserted that "[P]hilippou et al also states that *network interfaces* may be considered part of the computer system (column 3, 49-53)" (emphasis added). The Final Office Action, page 10, 3rd paragraph (Response to Arguments), also asserted "the *first device which is the network interface* which can also be

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connected to the to be configured box which makes it part of the second device . . ." (emphasis added). Thus the Final Office Action asserted that Philippou's network interface corresponds to the claimed first device. This assertion is contradictory to the Final Office Action's assertion discussed above that box 205 corresponded to the claimed first device. Alternatively speaking, the Final Office Action corresponded the claimed first device to both box 205 and "the network interface." However, the claimed first device is patentably distinguished from both box 205 and the network interface. If the claimed first device corresponds to Philippou's box 205, then Philippou, as discussed above, does not teach that box 205 *is embedded in a second device and provides administrative capabilities to this second device*. If Philippou's network interface corresponds to the claimed first device, then the Final Office Action failed to show that Philippou teaches the other claimed elements related to configuration of the claimed first device (or the corresponding network interface). That is, to be parallel with and thus anticipate claim 1, Philippou must teach that the network interface is coupled to the network communication channel; from box 201, sending the first parameter and a network interface's identifier to the communication channel; acquiring the first parameter upon identifying the network interface's identifier on the communication channel, and configuring the first parameter to the network interface, etc. However, the Final Office Action failed to show Philippou teaches such claimed elements.

Regarding the feature that the first device is embedded in a second device, the Advisory Action, page 9, 3rd paragraph asserted that "the first device which is the network interface which can also be connected to the to be configured box which makes it part of the second device." Claim 1 recites "the first device is embedded in a second device and provides administrative capabilities to the second device." If the network interface corresponds to the claimed first device, then, to be parallel with and thus anticipate the claimed invention, Philippou must teach that the network interface is embedded in a second device and provides administrative capabilities to this second device. However, both the Final Office Action and the Advisory Action failed to show that Philippou and Ylonen, either alone or in combination, teach that feature, i.e., the network interface being embedded in a second device and provides administrative capabilities to this second device. In any event, as discussed above, the claimed first device is patentably distinguished from Philippou's network interface.

Regarding the feature that the claimed first device provides administrative capabilities to a second device, the Advisory Action, page 8, last paragraph through page 9 first

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paragraph, asserted that "Philippou does disclose this feature [the first device provide
administrative capabilities to a second device] by disclosing that the computer system may be
used for the other boxes as well and will interface with external systems or boxes connected
on a network in turn providing administrative capabilities to, tools managing, and providing
interactions between a second and a third device to a second device (column 2, 60-67,
column 3, 43-50). Here, the Advisory Action, like the Final Office Action, changed it
position by corresponding the first claimed device to box 205 or a computer system, instead
of the network interface. Further, like the Final Office Action, the Advisory Action failed to
show that box 205/the computer system being embedded in a second device and provides
administrative capabilities to this second device.

b) Ylonen does not teach the claimed turning-off a feature to configure the first device
until the first device is in an un-configure state.

Even though Ylonen discloses "a network device may want to disable listening for
configuration packets once it has been configured" (col. 9, lines 1-2), Ylonen does not teach
the claimed element "turning-off a feature to configure the first device *until the first device is
in an un-configured state*" (emphasis added). Those skilled in the art will recognize that
many devices, after having been configured, prevents and/or is prevented from having a new
configuration to change the current configuration for ever. Ylonen discusses disabling
listening for configuration packets, but does not teach disabling it until the network device is
in an un-configured state. In contrast, the claimed invention does not allow new
configuration/change of the current configuration once the first device has been configured.
However, if the device is in an un-configured state again, then the claimed invention allows
the configuration. There is no such teaching in Ylonen.

The Advisory Action, page 9, 2nd paragraph, asserted that "Ylonen teaches that the
management station looks for new devices and if the device is in an un-configured state the
station will configure the device once is finds [sic] the device whether it is new or un-
configured (column 7, lines 1-20, column 9, lines 1-2)." Ylonen's cited paragraph of col. 7,
lines 1-20 discloses that to configure a new network device, the management station sends a
packet to the new network device. The packet will be addressed so that the new network
device will be able to see it. In an IP network, the configuration packet can be addressed to
the broadcast address of the network containing the new device. This causes all devices on
that physical network to see it. Other alternatives than using the broadcast address have been

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described. As can be seen, the cited paragraph does not disclose what the Advisory Action asserted. That is this cited paragraph does not disclose that if the device is in an un-configured state the station will configure the device. In any event, both the Final Office Action and the Advisory Action failed to show that either Philippou or Ylonen discloses the claimed turning-off a feature to configure the first device *until the first device is in an un-configured state*.

2) The alleged motivation for combining Philippou and Ylonen is improper. Showing of a prima facie case of obviousness fails

For combining two references in a § 103-obvious rejections, it must be shown that the references teach or suggest such combination or that such combination is of general knowledge (MPEP, section 706.02(j)). Here, there is no teaching or suggestion of combining Philippou and Ylonen in either Philippou or Ylonen, and the Final Office Action failed to show it is of common knowledge to combine the initialization of an uninitialized box of Philippou (Abstract) to the configuration of the network device of Ylonen (Abstract). The Final Office Action, page 3, 3rd paragraph, asserted that "it would have been obvious . . . to use the disabling feature in Ylonen with the method in Philippou et al because configuration data can be loaded in a reliable manner (Ylonen, column 2, 58-63)." Even though the Final Office Action correctly indicated that Ylonen desires to load configuration data into the network device in a reliable manner, the assertion of combining the two teachings of Philippou and Ylonen to achieve such goal is a general conclusory statement without providing supporting evidence. Therefore, showing of a prima facie of obviousness fails.

The Advisory Action, page 9, last paragraph indicated that "the examiner recognizes that obvious can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art . . . ." While the Advisory Action correctly cited the legal authority, the Advisory Action failed to apply the law to the current situation. That is, the Advisory Action, like the Final Office Action, failed to show that either Philippou or Ylonen teaches or suggests, or it is of common knowledge, to combine the teachings of Philippou and Ylonen.

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For the foregoing reasons, claim 1 is patentably distinguished from Philippou and Ylonen, either alone or in combination, and is therefore patentable.

Claims 16 and 19 recite limitations corresponding to claims 1 and are therefore patentable for the same reasons as claim 1.

CLAIMS 2, 18, 21

Claims 2, 18, and 21 depending from claims 1, 16, and 19, respectively, are patentable for at least the same reasons as claims 1, 16, and 19, respectively. Even if claims 1, 16, and 19 are not patentable, claims 2, 18, and 21 are patentable for their additional limitation "wherein the first device further provides console capabilities to the second device."

The Final Office Action, page 3, 4th paragraph, asserted that Philippou "discloses a network interface, which is part of and can be embedded in the first device and can provide console capabilities to the first device (column 3, 43-50)." The Final Office Action, page 9, 2nd paragraph (Response to Arguments) repeated this assertion. Here, the Final Office Action concluded that the network interface can provide console capabilities to the first device without showing that Philippou so teaches. In any event, even if this teaching exists in Philippour, claim 2 is patentably distinguished from this teaching because claim 2 recites that the *first device further provides console capabilities to the second device*, which is patentably distinguished from the network interface *providing console capabilities to the first device*. Additionally, in conjunction with the limitation in claim 1, the *claimed first device is embedded in a second device*, not *the second device (the network interface) being embedded in the first device* and providing console capabilities to the first device.

Philippou's cited paragraph of col. 3, lines 43-50 discloses "a conventional computer system 301 that may be included in the box 201 of FIG. 2. It will also be appreciated that a computer system 301 may be used to perform many of the functions [of] other boxes 203, 205, 207 and 209 . . . . The computer system 301 interfaces to external systems or boxes through the modem or network interface 319." Again, this cited paragraph does not disclose that the claimed first device (being embedded in the second device) further provides console capabilities to this second device.

The Final Office Action, page 9, 2nd paragraph (Response to Arguments), also asserted "[t]he computer system in Philippou may be used for the other boxes as well . . . . The first device which is the network interface which can also be connected to the to be configured box which makes it part of the second device and inherently since the network interface is

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providing the information from the configuring machine the device is providing console capabilities to the second device." The Advisory Action, page 10, 1st paragraph, repeated this assertion, and further asserted "[t]he first device by providing information from the configuring machine provides the second device with console capabilities by connecting the second device and delivering the device the capability to perform as a console." It is respectfully submitted that this assertion is without supporting evidence, and the Advisory Action failed to show what in Philippou correspond to the claimed first and second device, respectively. Additionally, Philippou does not disclose that the network interface (the first device) provides the to be configured box (the second device) with console capabilities by "connecting the second device [the to be configured box] and delivering the [second device] the capability to perform as a console." In any event, as discussed above, the claimed first device is patentably distinguished from Philippou's network interface.

CLAIM 3

Claim 3, depending from claims 1, is patentable for at least the same reasons as claims 1. Even if claim 1 is not patentable, claim 3 is patentable for its additional limitation "wherein the step of sending comprising the step of sending the first parameter to a table in the configuring machine; and obtaining the first parameter from the table."

The Final Office Action, page 3, last paragraph to page 4, first paragraph asserted that "Philippou . . . shows in Figure 4, a table, which holds the information for the network it has configured and sends information from this table to the device." The Advisory Action, page 10, second paragraph, repeated the Final Office Action's assertion on page 9, 3rd paragraph (Response to Arguments) that "the table in Philippou's figure 4 is from data collected prior to the configuration and it is well known in the art that this data is stored in a table before being accessed." It is respectfully submitted that Philippou's table 4 is a display of the boxes found after configuring utility 231 receives the acknowledgement from box 205, which is patentably distinguished from the claimed table in which the first parameter is sent to this table and, from this table, the first parameter is obtained so that it can be configured to the first device.

CLAIMS 5, 17, 20

Claims 5, 17, and 20, depending from claims 1, 16, and 19, respectively, are patentable for at least the same reasons as claims 1, 16, and 19, respectively. Even if claims

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1, 16, and 19 are not patentable, claims 5, 17, and 20 are patentable for their additional limitation "wherein the device's identifier is a media access control address of the first device."

The Final Office Action, page 4, 2nd paragraph and page 10, first paragraph (Response to Arguments), asserted that "Philippou et al discloses a unique identifier, which includes a serial number (column 3, 16-18). It is widely known that the media access control address is a unique device identifier." The Advisory Action, page 10, 3rd paragraph, repeated this assertion without addressing the arguement in the Final Response, which is hereby resubmitted: even for the sake of argument that the media access control address is a unique device identifier, the art of record, e.g., Philippou, does not disclose that the device identifier is a media access control address of the claimed first device. Those skilled in the art will recognize that various things may be used as a device identifier, and the embodiment of claims 5, 17, and 20 specifically selects the media access control address as this identifier for the claimed first device. However, there is no such disclosure in Philippou. To be parallel with and anticipate claims 5, 7, and 20, Philippou must, but does not, disclose using the media access control address of box 205 so that box 205 can be identified and thus configured. Since Philippou discloses using the serial number as a unique identifier for box 205, the claimed "media access control address" is patentably distinguished from this serial number of box 205 in Philippou.

CLAIM 6

Claim 6, depending from claims 1, is patentable for at least the same reasons as claims 1. Even if claim 1 is not patentable, claim 6 is patentable for its additional limitation *wherein the first device performing the step of acquiring the first parameter* (upon identifying the device's identifier on the communication channel).

The Final Office Action, page 4, 3rd paragraph, asserted that Philippour shows that network interface communicating with external systems and boxes. The Final Office Action, page 10, 2nd paragraph (Response to Arguments), then argued "the network interface communicating with external systems and boxes which *inherently* allows the first device to acquire the firs parameter (column 3, 48-50)" (emphasis added). The Advisory Action, page 11, 1st paragraph, repeated this assertion. As discussed above, there is no disclosure in Philippou that Philippou's network interface is the device to be configured, which corresponds to the claimed first device. Even if the network interface corresponds to the

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claimed first device, the assertion of inherency by the Final Office Action is improper
because the Final Office Action failed to provide evidence of inherency. That is, the Office
Action failed to show that it is inherent that the network interface acquires the parameter for
the network interface to be configured upon identifying the network interface's identifier on
the communication channel. Those skilled in the art will recognize that the claimed first
device may acquire the first parameter upon other conditions other than upon identifying the
device's identifier on the communication channel, such as acquiring this parameter from a
second device, etc. In brief, the fact that Philippou's computer system 301 interfaces to
external systems or boxes has nothing to do with the claimed "the first device performing the
step of acquiring the first parameter [upon identifying the device's identifier on the
communication channel."

CLAIM 7

Claim 7, depending from claims 1, is patentable for at least the same reasons as claim
1. Even if claim 1 is not patentable, claim 7 is patentable for its additional limitation
"wherein the step of acquiring comprises the steps of the second device obtaining the first
parameter, and acquiring the first parameter from the second device."

The Final Office Action, page 4, 4th paragraph, asserted that "[i]n Philippou et al . . .
the computer system may include the network interface as part of the system, which would
allow the second device to obtain, the first parameter and the first device acquire the first
parameter from the second device (column 3, 49-53)." The Final Office Action, page 10, 3rd
paragraph (Response to Arguments), also asserted "the first device which is the network
interface which can also be connected to the to be configured box which makes it part of the
second device and inherently since the network interface is providing the information from
the configuring machine the device is providing console capabilities to the second device."
The Advisory Action, page 11, 2nd paragraph, repeated this assertion. As discussed above,
the claimed first device is patentably distinguished from the network interface, and the
assertion of inherency is improper because the Final Office Action failed to provide evidence
for such inherency. Further, the assertion regarding "providing console capabilities to the
second device" has no thing to do with the claimed elements in claim 7. Additionally, the
fact that the network interfaces may be considered part of the computer system is not
patentably parallel to the claimed invention because the claimed first device is corresponded
to *box 205*, not the *interfaces*. In any event, if the network interface/box 205 corresponds to

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the claimed first device, then, to anticipate claim 7, Philippou and Ylonen, either alone or in combination, must disclose that the network interface/box 205 is embedded in a second device, this second device obtains the first parameter, and acquiring the first parameter from the second device. However, both the Final Office Action and the Advisory Action failed to show that Philippour or Ylonen disclose such features of the claimed invention.

CLAIM 8

Claim 8 has been canceled, and discussion related to canceled claim 8 was discussed above in relation to claim 1 because the feature of canceled claim 8 has been incorporated into claim 1.

CLAIM 9

Claim 9, depending from claims 1, is patentable for at least the same reasons as claim 1. Even if claim 1 is not patentable, claim 9 is patentable for its additional limitations "wherein the first device communicates with the second device via an interconnect selected from a group consisting of an input-output interconnect, a peripheral component interconnect bus, an industry standard architecture bus, an extended industry standard architecture bus, an infini band, and a personal computer memory card international association standard."

The Final Office Action, page 5, 1st paragraph, asserted "[f]igure 3 of Philippou et al discloses the second device being part of a bus which is widely known to consist of an input-output interconnect, a peripheral component interconnect bus, an industry standard architecture bus, an extended industry standard architecture bus, and inifi band, and a personal computer memory card international association standard." The Advisory Action, page 11, 3rd paragraph, asserted "the first device which is the network interface which can also be connected to the to be configured box which makes it part of the second device and Philippour et al discloses the second device being part of a bus which is widely known to consist of input-output interconnect, a peripheral component interconnect bus, an industry standard architecture bus, an extended industry standard architecture bus, and inifi band, and a personal computer memory card international association standard." To be parallel with and thus anticipate claim 9, Philippou must disclose that box 205/network interface being part of a second device, and that box 205/network interface communicates with this second device via an interconnect selected from the list of input-output interconnect, a peripheral component interconnect bus, an industry standard architecture bus, an extended industry

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standard architecture bus, and inifi band, and a personal computer memory card international association standard. However, Philippou does not disclose such facts. Further, as discussed above, Philippou does not disclose the claimed first device being embedded in the second claimed device, and therefore cannot disclose the communication between the claimed first device and claimed second device.

CLAIM 10

Claim 10, depending from claims 1, is patentable for at least the same reasons as claim 1. Even if claim 1 is not patentable, claim 10 is patentable for its additional limitation "wherein the device's identifier is selected from a group consisting of an internet protocol address of the second device, a media access control address of the second device, and an asynchronous transfer mode address of the second device."

The Final Office Action, page 5, 2nd paragraph asserted that "the unique identifier includes a serial number of the box, which is the second device (column 3, 16-18). It is widely known that the three options are well known unique identifiers." The Advisory Action, page 12, 1st paragraph, repeated this assertion without responding to the argument in the Final Response. Again, both Final Office Action's and Advisory Action' assertions are without supporting evidence, and Philippou does not disclose the device's identifier is from the claimed list of an internet protocol address of the second device, a media access control address of the second device, and an asynchronous transfer mode address of the second device. Philippou's serial number is patentably distinguished from the claimed device identifier in the list. Additionally, because, as discussed above, Philippou does not disclose the claimed second device, Philippou cannot disclose the internet protocol address of the second device, the media access control address of the second device, and the asynchronous transfer mode address of the second device.

CLAIM 4

Claim 4, depending from claims 3, is patentable for at least the same reasons as claim 3. Even if claim 3 is not patentable, claim 4 is patentable for its additional limitation "wherein the first parameter is an internet protocol address; an address resolution protocol command sending the internet protocol address to the table; and a packet internet groper protocol command obtaining the internet protocol address from the table."

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Ylonen's cited paragraph of column 7, lines 20-29 (Final Office Action page 5, 4th paragraph) discloses "[t]he configuration packet will typically contain the new device's device identifier . . ., the device's IP address, netmask, default gateway, and the management station's IP address and device identifier and/or public key. It may also contain information for setting up verification of the packet from the correct management station." Even though this cited paragraph discloses the device's IP address, it does not disclose, suggest or make obvious the claimed "an address resolution protocol command sending the internet protocol address to the table; and a packet internet groper protocol command obtaining the internet protocol address from the table."

The Advisory Action, page 12, 2nd paragraph, asserted "it is well known in the art that an address resolution protocol command is used to send to a table and a packet internet groper protocol command is able to obtain from a table." This assertion is improper because the Advisory Action failed to provide supporting evidence for such assertion. Even if the assertion is true, claim 14 includes the limitation that the first identifier is an internet protocol address, which is not taught in either Philippou or Ylonen, and claim 14 is therefore patentably distinguished from Philippou and Ylonen, either alone or in combination. Further, there are different ways transmit this internet protocol address, and claim 14 specifically uses the address resolution protocol command to send the internet protocol address to the table, and uses the internet groper protocol command to obtain the internet protocol address from the table, which is not taught in the prior art of record, e.g., Philippou and Ylonen.

For combining the two references in a § 103-obvious rejections, it must be shown that the references teach or suggest such combination or that such combination is of general knowledge (MPEP, section 706.02(j). The Final Office Action, page 6, 2nd paragraph, asserted that "it would have been obvious . . . to use Ylonen configuration packet structure and adapt it to work with the method of configuring a first device as taught by Philippou et al because a fast and effective way to send configuration data over the network to the unconfigured device is achieved." The Final Office Action failed to show that either Philippou or Ylonen teaches or suggests the combination as asserted. The Final Office Action also failed to show it is of general knowledge for such combination. The Final Office Action's assertion is a general conclusory statement without providing supporting evidence. Therefore, showing of a prima facie of obviousness fails.

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CLAIMS 12, 22

Claims 12 and 22, depending from claim 1 and 19, respectively, are patentable for at least the same reasons as claim 1 and 19, respectively. Even if claims 12 and 22 are not patentable, claims 12 and 22 are patentable for their additional limitation "the step of configuring a second parameter to the first device, the second parameter being sent with the first parameter in a packet."

The Final Office Action, page 6, 4th paragraph, asserted that "it would have been obvious . . . to use Ylonen's teaching of having multiple parameters sent in the packet and adapt it to work with the method of configuring a first device as taught by Philippou et al because information is provided to the device that is being configured to be able to validate that the data being sent is for the correct machine and is coming from the correct management system. This would provide a more efficient way to configure remote devices with less user interaction." The Final Office Action failed to show that either Philippou or Ylonen teaches or suggests the combination as asserted. The Final Office Action also failed to show it is of general knowledge for such combination. The Final Office Action's assertion is a general conclusory statement without providing supporting evidence. Therefore, showing of a prima facie of obviousness fails.

CLAIMS 13, 23

Claims 13 and 23, depending from claims 1 and 19, respectively, are patentable for at least the same reasons as claims 1 and 19, respectively. Even if claim1 and 19 are not patentable, claims 13 and 23 are patentable for their limitation "the step of sending a command with the first parameter in a packet, the command being executed in the first device."

The Final Office Action, 2nd paragraph, asserted "Yolonen teaches of a configuration packet, which will typically contain the new device's identifier, the device's IP address, netmask, default gateway, and the management station's IP address and device identifier and/or public key. It may also contain information for setting up verification of the packet from the correct management station (column 7, 20-29). The Final Office Action, page 11, 3rd paragraph (Response to Arguments), asserted "Ylonen teaches of a packet with a parameter and commands, which are in turn executed by the device (column 7, 1-7, 20-29). The Advisory Action, page 12, 3rd paragraph, repeated this assertion.

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Ylonen's cited paragraph of column 7, lines 1-7, discloses "[t]o configure a new network device that has been installed in the network, the management station sends at stage 601 a specifically formatted configuration packet to the new network device. The packet will be addressed so that the new network device will be able to see it. The exact method of doing this depends on the network protocol that is used and on the embodiment of the invention that is applied." Even though this paragraph discusses a configuration packet, the purpose of why the packet is addressed, etc., there is nothing about the claimed sending a command with the first parameter (to be configured to the claimed first device). There is nothing about the claimed command being executed in the claimed first device, either.

Ylonen's cited paragraph of column 7, lines 20-29 discloses "[t]he configuration packet will typically contain the new device's device identifier . . ., the device's IP address, netmask, default gateway, and the management station's IP address and device identifier and/or public key. It may also contain information for setting up verification of the packet from the correct management station." Again, there is nothing about the claimed sending a command with the first parameter (to be configured to the claimed first device). There is nothing about the claimed command being executed in the claimed first device, either.

The Final Office Action, page 7, 4th paragraph, asserted that "it would have been obvious . . . to use Ylonen's teaching of including the public key in the configuration packet and adapt it to work with the method of configuring a first device as taught by Philippou et al because a method is provided to the device that is being configured to be able to validate that the data being sent is for the correct machine and is coming form the correct management station. It would also allow the unconfigured device to configure itself with the data provided. This would provide a more efficient way to configure remote devices with less user interaction." The Final Office Action failed to show that either Philippou or Ylonen teaches or suggests the combination as asserted. The Final Office Action also failed to show it is of general knowledge for such combination. The Final Office Action's assertion is a general conclusory statement without providing supporting evidence. Therefore, showing of a prima facie of obviousness fails.

CLAIM 14

Claims 14, depending from claim 1, is patentable for at least the same reasons as claim 1. Even if claim 1 is not patentable, claims 14 is patentable for its limitation of "the step of acquiring comprises the step of checking whether the parameter is valid."

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The Final Office Action, page 8, 3rd paragraph, asserted that "it would have been obvious . . . to use Ylonen's authentication method and adapt it to work with the method of configuring a first device as taught by Philippou et al because a method is provided to the device that is being configured to be able to validate that the data being sent is for the correct machine and is coming form the correct management station. It would also allow the unconfigured device to configure itself with the data provided. This would provide a more efficient way to configure remote devices with less user interaction." The Final Office Action failed to show that either Philippou or Ylonen teaches or suggests the combination as asserted. The Final Office Action also failed to show it is of general knowledge for such combination. The Final Office Action's assertion is a general conclusory statement without providing supporting evidence. Therefore, showing of a prima facie of obviousness fails.

<u>CLAIM 15</u>

Independent claim 15 is pantentable for reasons that it recites limitations not disclosed in Philippou and Ylonen as discussed above in conjunction with claims 1-11. Limitations in claim 15 not disclosed in Philippou and Ylonen include, for example, turning-off a feature to configure the first device until the first device is in an un-configured state; wherein the first device is embedded in a second device and selected from a group consisting of a device provide tools managing the second device; a device providing mirror capabilities to the second device; a device providing interactions between the second device and a third device; and a device providing console capabilities to the second device.

The alleged motivation for combining Philippour and Ylonen is improper and showing of a prima facie of obviousness fails as discussed above in relation to claims 1, 15, and 19.

The Examiner is invited to telephone Appellant's undersigned attorney with regard to this matter.

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VIII. CLAIMS APPENDIX

Claims Involved in the Appeal of Application Serial No. 09/966,620

1   1. (Previously Presented) A method for configuring a first parameter to a first device,

2   comprising the steps of:

3   providing a network communication channel connected to the first device

4   and to a configuring machine;

5   from the configuring machine, sending the first parameter and a device's

6   identifier to the communication channel;

7   acquiring the first parameter upon identifying the device's identifier on the

8   communication channel;

9   configuring the first parameter to the first device; and

10   turning-off a feature to configure the first device until the first device is in

11   an un-configured state;

12   wherein the first device is embedded in a second device and provides

13   administrative capabilities to the second device.

1   2. (Previously Presented) The method of claim 1 wherein the first device further provides

2   console capabilities to the second device.

1   3. (Previously Presented) The method of claim 1 wherein the step of sending comprising

2   the steps of:

3   sending the first parameter to a table in the configuring machine; and

4   obtaining the first parameter from the table.

1   4. (Original) The method of claim 3 wherein:

2   the first parameter is an internet protocol address;

3   an address resolution protocol command sending the internet protocol

4   address to the table; and

5   a packet internet groper protocol command obtaining the internet protocol

6   address from the table.

1   5. (Original) The method of claim 1 wherein the device's identifier is a media access

2   control address of the first device.

1   6. (Original) The method of claim 1 wherein the first device performing the step of

2   acquiring the first parameter.

1   7. (Original) The method of claim 1 wherein the step of acquiring comprises the steps of:

2   the second device obtaining the first parameter, and

3   acquiring the first parameter from the second device.

1   8. (Canceled)

1   9. (Previously Presented) The method of claim 1 wherein the first device communicates

2   with the second device via an interconnect selected from a group consisting an

3   input-output interconnect, a peripheral component interconnect bus, an industry

4   standard architecture bus, an extended industry standard architecture bus, an infini

5   band, and a personal computer memory card international association standard.

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1   10. (Previously Presented) The method of claim 1 wherein the device's identifier is

2   selected from a group consisting of an internet protocol address of the second

3   device, a media access control address of the second device, and an asynchronous

4   transfer mode address of the second device.

1   11. (Canceled)

1   12. (Original) The method of claim 1 further comprising the step of configuring a second

2   parameter to the first device, the second parameter being sent with the first

3   parameter in a packet.

1   13. (Original) The method of claim 1 further comprising the step of sending a command

2   with the first parameter in a packet, the command being executed in the first

3   device.

1   14. (Original) The method of claim 1 wherein the step of acquiring comprises the step of

2   checking whether the first parameter is valid.

1   15. (Previously Presented) A method for configuring a parameter to a first device,

2   comprising the steps of:

3   providing a network communication channel connected to the first device

4   and to a configuring machine;

5   from the configuring machine, sending the parameter and a device's

6   identifier to the communication channel;

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7   acquiring the parameter upon identifying the device's identifier on the

8   communication channel;

9   configuring the parameter to the first device; and

10   turning-off a feature to configure the first device until the first device is in

11   an un-configured state;

12   wherein the first device is embedded in a second device and selected from

13   a group consisting of

14   a device providing tools managing the second device;

15   a device providing mirror capabilities to the second device;

16   a device providing interactions between the second device and a

17   third device; and

18   a device providing console capabilities to the second device.

1   16. (Previously Presented) A network comprising:

2   a first device being embedded in a second device and providing

3   administrative capabilities to a second device;

4   a network communication channel connecting the first device and a

5   configuring machine;

6   means for sending a network address and a device's identifier from the

7   configuring machine to the communication channel;

8   means for acquiring the network address upon identifying the device's

9   identifier on the communication channel; and

10   means for the first device to configure the network address to the first

11   device;

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12   wherein after the first device is configured with the network address, a

13   feature to configure the first device is turned off until the first

14   device is in an un-configured state.

1   17. (Original) The network of claim 16 wherein the device's identifier is a media access

2   control address of the first device.

1   18. (Previously Presented) The network of claim 16 wherein the first device further

2   provides console capabilities to the second device.

1   19. (Previously Presented) A computer-readable medium embodying instructions for a

2   computer to perform a method for configuring a network address to a first device,

3   the method comprising the steps of:

4   providing a network communication channel connected to the first device

5   and to a configuring machine;

6   from the configuring machine, sending the network address and a device's

7   identifier to the communication channel;

8   acquiring the network address upon identifying the device's identifier on

9   the communication channel;

10   configuring the network address to the first device; and

11   turning-off a feature to configure the first device until the first device is in

12   an un-configured state;

13   wherein the first device is embedded in a second device and provides

14   administrative capabilities to the second device.

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1   20. (Previously Presented) The computer-readable medium of claim 19 wherein the

2   device's identifier is a media access control address of the first device.

1   21. (Previously Presented) The computer-readable medium of claim 19 wherein the first

2   device further provides console capabilities to the second device.

1   22. (Previously Presented) The computer-readable medium of claim 19 wherein the

2   method further comprising the step of configuring a second parameter to the first

3   device, the second parameter being sent with the first parameter in a packet.

1   23. (Previously Presented) The computer-readable medium of claim 19 wherein the

2   method further comprising the step of sending a command with the first parameter

3   in a packet, the command being executed in the first device.

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IX.   EVIDENCE APPENDIX

No evidence was submitted pursuant 37 C.F.R. §§ 1.130, 1.131, and/or 1.132, nor was evidence entered by the Examiner and relied upon by the Appellant in the appeal.

X.   RELATED PROCEEDINGS APPENDIX

Appellant is unaware of any related proceedings, including appeals or interferences.

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